

REMARKS/ARGUMENTS

The Pending Claims

Claims 1, 3, 4, 7-18, 20-22, 24-28, 30-33 and 36-42 remain pending.

Claims 4, 16, 24, 25 and 36 have been amended to describe the invention more clearly. No new matter has been added, the basis for the amended claim language may be found within the original specification, claims and drawings.

THE OFFICE ACTION

Restriction Requirement

The Official Action mailed January 5, 2006 asserts there are two distinct inventions (identified as Groups I - II) claimed in the referenced application.

The Official Action asserts that the groups are not so linked so as to form a single general inventive concept under PCT Rule 13.1.

ELECTION OF GROUP WITH TRAVERSE

In order to comply with the requirements of the Patent and Trademark Office, Applicants provisionally elect, *with traverse*, Group I (claims 1, 3-5, 7-18, 20-22, 24-28, 30-33, and 36-42) drawn to a method for producing beer through a porous membrane and cleaning the membrane with an amylase and/or a cellulase, or with a cellulase with the recited properties.

Claim 36 has been amended to depend from an independent claim in Group I as suggested in the Office Action. Thus, it is believed claim 36 remains included in Group I for examination purposes.

Allowable Subject Matter

Applicants are pleased to note the Office Action indicates claims 1 and 3 are currently allowable.

Applicants also note the Office Action indicates claims 4, 5, 7-18, 20-22, 24-28, 30-33 and 37-42 would be allowable if amended to recite the cellulase in a closed group. The claims have been so rewritten as noted below.

DISCUSSION

Restriction

As an initial point, Applicants note a first restriction requirement was issued in this application in 2002, and now this second restriction was issued four years later, after an Appeal Brief was filed. The 18 month time period between Applicants filing an Appeal Brief and this Office Action withdrawing the finality of the last Office Action (a period during which the undersigned repeatedly contacted the Patent Office regarding the status of the Examiner's Answer) is also noted.

The claims of both Groups relate to embodiments of methods for producing beer comprising filtering beer through a porous membrane and cleaning the membrane. Thus, any search and consideration of the claimed subject matter of Group I will likely overlap and encompass that for the claimed subject matter of Group II. Accordingly, the searches for these two groups of claims cannot in any way be said to be completely "distinct" or "independent." This does not mean that the claims necessarily stand or fall together, but the overlapping nature of the searches remains and mitigates against a restriction requirement.

Examination of the patent application would be most expeditious by examining all pending claims together. As Section 803 of the MPEP explains, there are two criteria for a proper requirement for restriction between patentably distinct inventions: (i) the inventions must be independent or distinct as claimed, and (ii) there must be a serious burden on the Examiner if restriction is not required. Consequently, as set forth in MPEP 803:

If the search and examination of all of the claims in an entire application can be made without serious burden, the Examiner must examine them on the merits, even though they include claims to distinct or independent inventions.

The restriction requirement is improper because the Examiner has not shown that a search and examination of the entire application would, indeed, cause a *serious* burden, as required by Section 803 of the MPEP for proper restriction. In fact, a serious burden would arise only if examination of the patent application were restricted to one of the claim groups. Filing additional patent applications containing the non-elected claims would unnecessarily burden (1) the Patent and Trademark Office, since it must assume the additional labor involved in examining at least two separate applications; (2) the public, since it will have to analyze at least two patents (assuming the subject matter of each claim group is found patentable) to ascertain all of the claimed subject matter; and (3) the Applicants, since the

Applicants must bear the substantial financial burden and delays associated with prosecution of multiple patent applications and the payment of maintenance fees for multiple patents.

With respect to delays associated with prosecution, the delays associated with the prosecution of the present application further illustrate Applicants' point.

While the inventions defined by the claims may be distinct or independent, there is no demonstration that the search and examination of all the pending claims would entail a serious burden to the Examiner. In particular, it is submitted that any additional burden on the Examiner in considering Groups I and II together is not so serious as to require restriction, and therefore, Applicants respectfully request withdrawal of the restriction requirement.

Nevertheless, in view of the delays referenced earlier, and in order to expedite matters at this late date, the independent claim in Group II (claim 29) has been canceled without prejudice, and claim 36 has been amended to depend from claim 1.

Examiner's Notes

The Office Action indicates claims 4, 5, 7-18, 20-22, 24-28, 30-33 and 37-42 would be allowable if amended to recite the cellulase in a closed group.

In order to expedite matters at this late date and allow the application to pass to issuance, while the Office Action has not pointed to a teaching in WO 96/23579 of a cellulase having a crystalline:soluble cellulase activity ratio at 60 minutes of at least about 0.1, independent claim 4 has been amended to recite the cellulase in a closed group.

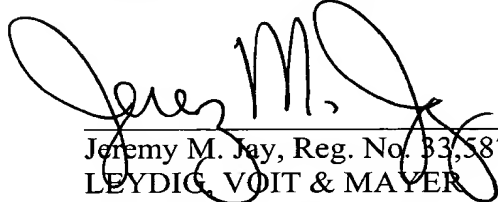
Claim 36 has been amended to depend from claim 1, and is distinct from claim 4 as amended, and is thus believed allowable. The dependencies of claims 16, 24, and 25 have been amended for clarity.

Conclusion

If, in the opinion of the Examiner, a telephone conference would expedite the

prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jeremy M. Jay", is written over a horizontal line.

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